

REMARKS

I. Amendments

By this amendment, claims 2, 3, 9-16, 18, 25 and 26 have been amended and claims 33 and 34 have been added.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

Specifically, support for new claims 33 and 34 is found in claim 25 as originally filed.

No change of inventorship is necessitated by this amendment.

II. Request for Consideration of a Previously Submitted Information Disclosure Statement

On March 11, 2003, Applicants submitted an Information Disclosure Statement to disclose four references B1-B4. Applicants respectfully request the Examiner's consideration of the previously submitted references. Should the Examiner not have the references on file, he is requested to contact Applicants' Attorney to obtain copies.

III. Discussion of the Objection to Claims 13-16

The Examiner has indicated that claims 13-16 are objected to only as being dependent upon a rejected base claim, and that the claims would be allowable if re-written in independent form. Applicants have re-written the claims as independent claims by this amendment, but request that the Examiner review the claims in light of the March IDS (as indicated in Sec. II above) to confirm their allowability.

IV. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph of Claims 1-6, 9-12, 17-19 and 25-28

Claims 1-6, 9-12, 17-19 and 25-28 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Specifically, the Office Action stated that use of the terms "further substituted" and "optionally substituted" are vague. Applicants respectfully traverse the rejection.

By this amendment, the phrase "optionally substituted" has been replaced by "unsubstituted or substituted" in claims 2, 3, 6, 10, 11, 12 and 18.

Applicants assert that the optional or further substituents recited in the pending claims are fully explained in the specification. Applicants would like to direct the Examiner's attention to the following portions of the specification, to demonstrate the support for independent claims 1, 19, 25-28 and new claims 33 and 34.

Further substituents of Ring A are disclosed on page 34, line 13 – page 37, line 7.

Further substituents of Ring B are disclosed on page 38, line 4 – page 41, line 5.

Further substituents of Ring C are disclosed on page 41, lines 21-25.

Claims 2-6, 9-12, 17 and 18 depend upon claim 1. Applicants submit that the more specific dependent claims are also sufficiently clear for the reasons provided above. Therefore Applicants request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection of claims 1-6, 9-12, 17-19 and 25-28.

V. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph of Claims 1-12, 17-19 and 25-28

Claims 1-12, 17-19 and 25-28 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the

subject matter which Applicants regard as their invention. Specifically, the Office Action stated that use of the term "acyl" is indefinite. Applicants respectfully traverse the rejection.

The term "acyl" is defined in the specification at page 32, lines 22-24. Moreover, specific examples are provided on page 32, line 25 – page 33, line 24. Applicants respectfully submit that the use of the term in the pending claims is not indefinite in light of the teachings of the specification.

Therefore Applicants request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection of claims 1-12, 17-19 and 25-28.

VI. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph of Claims 10-12

Claims 10-12 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Specifically, the Office Action stated that use of the phrase "cyclic amino group" is indefinite. Applicants respectfully traverse the rejection.

Applicants have defined "cyclic amino group" on page 31, line 18 – page 32, line 4 of the specification. This definition includes specific examples. Applicants assert therefore that their use of this phrase is not indefinite.

Therefore Applicants request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection of claims 10-12.

VII. Discussion of the Rejection under 35 U.S.C. Sec. 112, Second Paragraph of Claims 17, 19 and 25-28

Claims 17, 19 and 25-28 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. Specifically, the Office Action stated that use of the term "prodrug" is indefinite. Applicants respectfully traverse the rejection.

As an initial matter, Applicants wish to point out to the Examiner that new claims 33 and 34 also contain the term "prodrug".

Applicants believe that their specification provides adequate guidance to enable one skilled in the art to determine relevant prodrugs of the compounds of the pending claims. Applicants would like to direct the Examiner's attention to pages 119 and 120, wherein pertinent prodrugs are described.

Therefore Applicants request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection of claims 17, 19 and 25-28.

VIII. Discussion of the Rejection under 35 U.S.C. Sec. 112, First Paragraph of Claims 17, 19 and 25-28

Claims 17, 19 and 25-28 have been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement for prodrugs. Applicants respectfully traverse the rejection.

Applicants hereby incorporate their arguments found in Sec. VII. above in response to this rejection.

Therefore Applicants request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claims 17, 19 and 25-28.

IX. Discussion of the Rejection under 35 U.S.C. Sec. 112, First Paragraph of Claims 25-28

Claims 25-28 have been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement for treating diseases other than cranial trauma. Applicants respectfully traverse the rejection, as Applicants believe that their specification provides adequate support for their invention as set forth in the pending claims as amended.

As an initial matter, Applicants note that independent claim 28 is directed to a method for inhibiting lipid peroxidation. This claim is enabled by an experiment which studies the effect of the compounds of the present invention on lipid peroxide peroxidation, provided on page 188, line 25 – page 190, line 5 of the specification. The results show that lipid peroxidation inhibition could be effected with compounds of the present invention. In addition, the accompanying Declaration by Dr. Hashimoto shows the lipid peroxidation inhibitory activity of more compounds of the present invention.

Moreover, new claim 33 has been specifically directed to treatment of cranial trauma, which the Examiner has already stated is enabled.

As to the diseases and conditions of claims 25, 26, 27 and new claim 34, Applicants believe these claims are adequately supported by the specification as well, since lipid peroxidation inhibitors can be useful to treat the recited diseases and conditions, as is understood by those skilled in the art. On page 7, line 6 – page 8, line 6 the relationship of lipid peroxidation inhibition to the recited diseases and conditions is discussed. Further indication of the relationship may be found in the Braugher *et al.* reference provided as attached Appendix A, and in the Ohkawa *et al.* reference provided as attached Appendix B for the Examiner's convenience.

Furthermore, methods of administration of the compounds are discussed on page 121, line 20 – page 123, line 5.

Therefore Applicants request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claims 25-28.

X. Discussion of the Second Rejection under 35 U.S.C. Sec. 112, First Paragraph of Claims 25-28

Claims 25-28 have also been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement for preventing any diseases. Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claim 28 as originally filed does not contain the term “preventing” and therefore should not be subject to this rejection.

By this amendment, “preventing” has been deleted from claim 26. In addition, new claims 33 and 34 have been added which includes subject matter from claim 25. The new claim does not include “preventing”.

However, “preventing” has been retained in claims 25 and 27. This is so because Applicants believe that these conditions can be prevented with the compounds as recited in the pending claims.

Therefore Applicants request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claims 25-28.

XI. Conclusion

Reconsideration of the claims and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

Dated: November 6, 2003

Elaine M. Ramesh

(847) 383-3391

(847) 383-3372

Elaine M. Ramesh, Ph.D., Reg. No. 43,032

Mark Chao, Ph.D., Reg. No. 37,293

Attorney for Applicants

Customer No. 23,115

Takeda Pharmaceuticals North America, Inc.
Intellectual Property Department
Suite 500, 475 Half Day Road
Lincolnshire, IL 60069 USA

Certificate of Mailing under 37 CFR 1.10

The undersigned hereby certifies that this document, along with any attachments, is being deposited in an envelope addressed to The Commissioner of Patents and Trademarks, with sufficient postage with the United States Postal Service EXPRESS MAIL Post Office to Addressee Service on this date November 6, 2003.

Express Mail Label No. EV 310944294 US

Gail L. Winokur

Printed Name: Gail L. Winokur